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PTO/SB/21 (08-00)  
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# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number Of Pages In This Submission

6

Application Number

09/905,405

Filing Date

July 13, 2001

First Named Inventor

James CHEN

Group Art Unit

3764

Examiner Name

To be assigned

Attorney Docket No.

398032000700

## ENCLOSURES (check all that apply)

☐ Fee Transmittal Form

☐ Fee Attached

☐ Amendment / Reply

☐ After Final

☐ Affidavits/declarations

☐ Extension of Time Request

☐ Express Abandonment Request

☒ Information Disclosure Statement (3 pages)

☐ Certified Copy of Priority Document(s)

☐ Response to Missing Parts/  
Incomplete Application

☐ Response to Missing Parts  
under 37 CFR 1.52 or 1.53

☐ Assignment Papers  
(for an Application)

☐ Drawing(s)

☐ Licensing-related Papers

☐ Petition

☐ Petition to Convert to a  
Provisional Application

☐ Power of Attorney, Revocation  
Change of Correspondence Address

☐ Terminal Disclaimer

☐ Request for Refund

☐ CD, Number of CD(s) \_\_\_\_\_

☐ After Allowance Communication to  
Group

☐ Appeal Communication to Board of  
Appeals and Interferences

☐ Appeal Communication to Group  
(Appeal Notice, Brief, Reply Brief)

☐ Proprietary Information

☐ Status Letter

☒ Other Enclosure(s) (please identify  
below):

1. Form PTO-1449 (2 pages);
2. Twenty-two (22) references;
3. Return/receipt postcard.

Remarks

## SIGNATURE OF APPLICANT, ATTORNEY OR AGENT

Firm  
or  
Individual Name

Charles D. Holland  
Morrison & Foerster LLP  
755 Page Mill Road  
Palo Alto, CA 94304

Signature

Charles D. Holland, Registration No. 35,196

Date

October 26, 2001

## CERTIFICATE OF MAILING BY "FIRST CLASS MAIL"

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on October 26, 2001.

Patricia A. Johnson

Burden Hours Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.



PATENT  
Docket No. 398032000700

CERTIFICATE OF MAILING BY "FIRST CLASS MAIL"

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Commissioner of Patents, Washington, D.C. 20231, on Oct. 26, 2001.

Patricia Johnson  
Patricia Johnson

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

James CHEN

Serial No.: 09/905,405

Filing Date: July 13, 2001

For: COMPOSITIONS AND METHODS FOR  
THE TREATMENT OF METABOLIC  
BONE DISORDERS AND BONE  
METASTASES

Examiner: To be assigned

Group Art Unit: 3764

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INFORMATION DISCLOSURE  
STATEMENT UNDER 37 C.F.R. § 1.97 AND § 1.98

Commissioner of Patents  
Washington, D.C. 20231

Dear Sir:

Pursuant to 37 C.F.R. § 1.97 and § 1.98, Applicant submits for consideration in the above-identified application the documents listed on the attached Form PTO-1449. Copies of the documents are also submitted herewith. The Examiner is requested to make these documents of record.

This Information Disclosure Statement is submitted:

- ☒ Within three months of the application filing date or before mailing of a first Office Action on the merits; accordingly, no fee or separate requirements are required.
- ☐ After receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance.
  - ☐ A fee is required. A check in the amount of \* is enclosed.
  - ☐ A fee is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.
  - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided below; accordingly, no fee is believed to be due.
- ☐ After mailing of a final Office Action or Notice of Allowance, but before payment of the issue fee. Accordingly, a Petition requesting consideration of the Information Disclosure Statement, an authorization to charge our deposit account, and a Certification under 37 C.F.R. § 1.97(e) are provided herein.

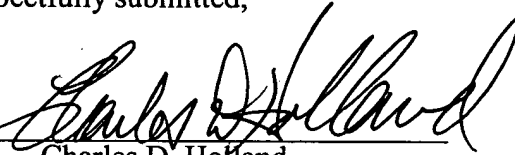
Applicant would appreciate the Examiner initialing and returning the Form PTO-1449, indicating that the information has been considered and made of record herein.

The information contained in this Information Disclosure Statement under 37 C.F.R. § 1.97 is to the best of my knowledge and is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the above information constitutes prior art to the subject invention.

In the unlikely event that the Patent Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing **398032000700**. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: Oct-23, 2001

Respectfully submitted,

By:   
Charles D. Holland  
Registration No. 35,196

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Form PTO-1449

Docket Number 398032000700

Application Number 09/905,405

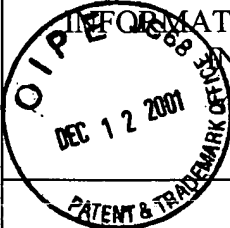
INFORMATION DISCLOSURE CITATION  
IN AN APPLICATION

Applicant

James C. CHEN

Filing Date July 13, 2001

Group Art Unit 3764

Mailing Date Oct. 26, 2001

(Use several sheets if necessary)

## U.S. PATENT DOCUMENTS

Examiner Initials	Ref. No.	Date	Document No.	Name	Class	Subclass	Filing Date If Appropriate
	1.	02/27/1996	5,494,793	Schindele et al.			
	2.	08/06/1996	5,543,514	Sessler et al.			
	3.	10/15/1996	5,565,552	Magda et al.			

## FOREIGN PATENT DOCUMENTS

Examiner Initials	Ref. No.	Date	Document No.	Country	Class	Subclass	Translation YES NO
	4.	01/09/1992	WO 92/00106	WIPO			
	5.	09/04/1997	WO 97/31582	WIPO			
	6.	07/26/1978	51-159879	Japan			YES
	7.	11/15/1982	57-185220	Japan			YES

## OTHER DOCUMENTS

(including author, title, Date, Pertinent Pages, Etc.)

Examiner Initials	Ref. No.	Title
	8.	Devoisselle, J.M. et al., (1995) "Effect of indocyanin green formulation on blood clearance and in vivo fluorescence kinetic profile of skin" <i>SPIE</i> 2627:100-108.
	9.	Kreimer-Birnbaum, M. (1989) "Modified porphyrins, chlorins, phthalocyanines, and purpurins: second-generation photosensitizers for photodynamic therapy" <i>Sem. Hematol.</i> 26(2):157-173.
	10.	Lourwood, D.L. (1998) "The pharmacology and therapeutic utility of bisphosphonates" <i>Pharmacotherapy</i> 18(4):779-789.
	11.	Meerovich, G.A. et al., (1996) "Photosensitizer for PDT based on phosphonate phthalocyanine derivative" <i>SPIE</i> 2924:86-90.
	12.	Papapoulos, S.E. (1997) "Bisphosphonates: structure-activity relations from a clinical perspective" <i>Medicina</i> 57(Suppl. 1): 61-64.
	13.	Nakatani, Y. et al., (1981) "Chemistry and biochemistry of Chinese drugs. VII. Cytostatic pheophytins from silkworm excreta, and derived photocytotoxic pheophorbides" <i>Chem. Pharm. Bull.</i> 29(8):2261-2269.
	14.	Nemoto, R. et al., (1993) "Inhibition by a new bisphosphonate (YM175) of bone resorption induced by the MBT-2 tumour of mice" <i>British Journal of Cancer</i> 67(5):893-897.

EXAMINER:

DATE CONSIDERED:

EXAMINER: Initial if citation considered, whether or not the citation conforms with MPEP 609. Draw a line through the citation if not in conformance and not considered. Include a copy of this form with next communication to applicant.

Form PTO-1449		Docket Number 398032000700	Application Number 09/905,405
<b>INFORMATION DISCLOSURE CITATION IN AN APPLICATION</b> (See several sheets if necessary)		Applicant James C. CHEN	
		Filing Date July 13, 2001	Group Art Unit 3764
		Mailing Date <u>Oct. 26</u> , 2001	
	15.	Sharman, W.M. et al., (1996) "Novel water-soluble phthalocyanines substituted with phosphonate moieties on the benzo rings" <i>Tetrahedron Letters</i> 37(33):5831-5834.	
	16.	Umemura et al., (1996) "Recent advances in sonodynamic approach to cancer therapy" <i>Ultrasonics Sonochemistry</i> 3:S187-S191.	
	17.	Yamamoto, T. (December 10, 1974) "Effect of phytochlorin on transplantable cancer cells" <i>Medicine and Biology</i> 89(6):433-438, English translation and certificate of translation included, 7 pages.	
	18.	Yamamoto, T. (April 10, 1975) "Suppression of tumors by the photodynamic action of phytochlorin sodium" <i>Medicine and Biology</i> 90(4):161-164, English translation and certificate of translation included, 4 pages.	
	19.	Yamamoto, T. and Miyagawa, F. (June 10, 1975) "Photodynamic effects on the nucleic acids of cancer cells sensitized by sodium phytochlorin" <i>Medicine and Biology</i> 90(6): 397-400, English translation and certificate of translation included, 4 pages.	
	20.	Yamamoto, T. and Miyagawa, F. (1978) "Photoradiation therapy, phytochlorin and visible light" <i>Prevention and Detection of Cancer, Part 1, Prevention. Volume 2, Etiology-Prevention Methods</i> Proceedings of the Third International Symposium on Detection and Prevention of Cancer held April 26, 1976 in New York, NY, 1(2):1789-1802.	
	21.	Yumita et al., (1997) "Sonodynamically induced antitumor effect of gallium-porphyrin complex by focused ultrasound on experimental kidney tumor" <i>Cancer Letters</i> 112:79-86.	
	22.	Yumita et al., (1987) "The combination treatment of ultrasound and antitumor drugs on yoshida sarcoma" <i>Japan J. Hyperthermic Oncology</i> 3(2):175-182.	
EXAMINER: _____ DATE CONSIDERED: _____			
EXAMINER: Initial if citation considered, whether or not the citation conforms with MPEP 609. Draw a line through the citation if not in conformance and not considered. Include a copy of this form with next communication to applicant.			